

REMARKS

Specification

In the specification, the Abstract and paragraph [0018] have been amended to correct minor editorial problems.

Summary

Claims 1-4 and 6-19 stand in this application. Claims 1, 6, 9, 11, 14 and 16 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested

Allowable Claims

We would like to thank the Examiner for indicating the allowability of claims 9 and 14 if amended to include all of the limitations of the base claims and any intervening claims. Applicant respectfully submits that claims 9 and 14 have been amended into independent form and are currently in condition for allowance.

Claim Objections

Claims 11-15 were objected to for informalities. Applicant respectfully submits that claim 11 has been amended in accordance with the suggestions set forth within the office action. Therefore, Applicant respectfully requests removal of the claim objections to claim 11 and any claim depending therefrom.

35 U.S.C. § 102

At page 3, paragraph 5 of the Office Action claims 1-3, 5, 17, 18 and 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Kuffner, United States Patent Pub. No. 2003/0235167 (hereinafter “Kuffner”). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 6, 9, 11, 14 and 16 in order to facilitate prosecution on the merits. Applicant submits that the amendments merely clarify, either expressly or impliedly, what was already present in the claims. Furthermore, Applicant submits that the amendments are not narrowing amendments and are not being made for reasons substantially related to patentability.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See MPEP § 2131*, for example. Applicant submits that Kuffner fails to teach each and every element recited in claims 1-3, 5, 17, 18 and 20 and thus they define over Kuffner. For example, with respect to claim 1, Kuffner fails to teach, among other things, the following language:

a beacon transceiver to transmit a beacon to a remote device, wherein a beacon transmitted by said beacon transceiver provides an indication of the one or more available radio communication protocols

According to the Office Action, this language is disclosed by Kuffner at Figures 4, 6 and paragraph [0032]. Applicant respectfully disagrees.

Applicant respectfully submits that claim 1 defines over Kuffner. Kuffner at the given cite, in relevant part, states:

A multiple mode transceiver arrangement such as 300 may be deployed in accordance with a process such as process 600 of FIG. 6. At 602, the user configures the available communication resources until the resources reach their limit. If the resources are exceeded at 606, the user is informed at 610. Otherwise, the system manager 110 deploys the available resources at 614 by sending configuration control information to the various configurable components.

As indicated above, Kuffner arguably discloses a user configurable transceiver arrangement that comprises configurable components. By way of contrast, the claimed subject matter discloses, "a beacon transceiver to transmit a beacon to a remote device, wherein a beacon transmitted by said beacon transceiver provides an indication of the one or more available radio communication protocols". Kuffner arguably shows a system that is configurable by a user, however, fails to disclose a beacon transceiver that transmits a beacon to a remote device. In fact, Kuffer fails to a beacon transceiver or a beacon within its disclosure. The Office Action argues that "it is inherent that the user receives a beacon that has information about the availability of the communication resources." Applicant respectfully submits that "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Applicant respectfully submits that the Office Actions fails to provide a factual basis that proves the only way for a user to configure the available communication resources is to use "a beacon transceiver to transmit a beacon to a remote device, wherein a beacon transmitted by said beacon transceiver provides an indication of the one or more available radio communication protocols." Consequently, Kuffner fails to disclose all the elements or features of the claimed subject matter. Accordingly,

Applicant respectfully requests removal of the anticipation rejection with respect to claim 1. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 2-4, which depend from claim 1 and, therefore, contain additional features that further distinguish these claims from Kuffner.

Claims 6, 11 and 16 recite features similar to those recited in claim 1. Therefore, Applicant respectfully submits that claims 6, 11 and 16 are not anticipated and are patentable over Kuffner for reasons analogous to those presented with respect to claim 1. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claims 6, 11 and 16. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to all claims that depend from claims 6, 11 and 16 and therefore contain additional features that further distinguish these claims from Kuffner.

At page 5, paragraph 6 of the Office Action claims 6, 7, 11 and 12 stand rejected under 35 U.S.C. § 102 as being anticipated by Phillips, United States Patent No. 6,188,898 (hereinafter “Phillips”). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 6, 9, 11, 14 and 16 in order to facilitate prosecution on the merits. Applicant submits that the amendments merely clarify, either expressly or impliedly, what was already present in the claims. Furthermore, Applicant submits that the amendments are not narrowing amendments and are not being made for reasons substantially related to patentability.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See MPEP* § 2131, for example. Applicant submits that Phillips fails to teach each and every element recited in claims 6, 7, 11 and 12 and thus they define over Phillips. For example, with respect to claim 6, Phillips fails to teach, among other things, the following language:

transmitting from a beacon transceiver a beacon to a remote device, wherein a beacon transmitted by said beacon transceiver provides an indication of a desired radio communication protocol;

According to the Office Action, this language is disclosed by Phillips at Col. 3, lines 20-
23. Applicant respectfully disagrees.

Applicant respectfully submits that claim 1 defines over Phillips. Phillips at the given cite, in relevant part, states:

In the network of FIG. 1, the base stations operate at appropriate frequencies to provide a communications service and also provide a beacon function for those mobile communications protocols that require such a function. For example, the system may provide access to mobile terminals using the GSM 900, DECT, and DCS 1800 protocols.

As indicated above, Phillips arguably discloses base stations that provide a beacon function. By way of contrast, the claimed subject matter discloses, “transmitting from a beacon transceiver a beacon to a remote device, wherein a beacon transmitted by said beacon transceiver provides an indication of a desired radio communication protocol.” Phillips arguably a beacon function in general, however, fails to show “wherein a beacon transmitted by said beacon transceiver provides an indication of a desired radio communication protocol.” Consequently, Phillips fails to disclose all the elements or

features of the claimed subject matter. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 6. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claim 7, which depends from claim 6 and, therefore, contain additional features that further distinguish these claims from Phillips.

Claim 11 recites features similar to those recited in claim 6. Therefore, Applicant respectfully submits that claim 11 is not anticipated and is patentable over Phillips for reasons analogous to those presented with respect to claim 6. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 11. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claim 12 which depends from claim 11 and therefore contains additional features that further distinguish this claim from Phillips.

35 U.S.C. § 103

Claims 4, 16 and 19 were rejected under 35 USC § 103(a) as being unpatentable over Kuffner (U.S. 2003/0235167) in view of Allison et al. (U.S. 6,167,032).

Claims 8 and 13 were rejected under 35 USC § 103(a) as being unpatentable over Phillips (U.S. 6,188,898) in view of Kuffner (U.S. 2003/0235167).

Claims 10 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Phillips (U.S. 6,188,898) in view of Allison et al. (U.S. 6,167,032).

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. *See* MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 4, 8, 10, 13, 15, 16 and 19. Therefore claims 4, 8, 10, 13, 15, 16 and 19 define over the cited references, whether taken alone or in combination. Applicant respectfully submits that independent claims 1, 6, 11 and 16 are patentable in light of the arguments presented above. Furthermore, Applicant respectfully submits that he is unable to find a teaching of the amended limitations within the cited references. Consequently, the cited references, whether taken alone or in combination, fail to disclose all the elements or features of the claimed subject matter. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 4, 8, 10, 13, 15, 16 and 19.

Conclusion

For at least the above reasons, Applicant submits that claims 1-4 and 6-19 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1-4 and 6-19 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

Appl. No. 10/812,648
Response Dated November 28, 2007
Reply to Office Action of August 9, 2007

Docket No.: 1020.P18387
Examiner: Foud, Hicham B.
TC/A.U. 2616

The Examiner is invited to contact the undersigned at 724-933-9338 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to deposit account 50-4238.

Respectfully submitted,

KACVINSKY LLC

/John F. Kacvinsky/

John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

Dated: November 28, 2007

KACVINSKY LLC
C/O Intelleivate
P.O. Box 52050
Minneapolis, MN 55402
(724) 933-5529